



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,715	03/19/2002	Alex Roche	B-4537PCT 619589-5	7580
36716	7590	10/07/2005	EXAMINER	
LADAS & PARRY 5670 WILSHIRE BOULEVARD, SUITE 2100 LOS ANGELES, CA 90036-5679			SMITH, JEFFREY A	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,715

Applicant(s)

ROCHE, ALEX

Examiner

Jeffrey A. Smith

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-31 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

LC

Art Unit: 3625

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) claims 1-12, drawn to a method of operating an on-line retailing operation for retailing of at least one print product to a customer.

Group II, claim(s) 13-15, drawn to an on-line image content retailer operation.

Group III, claim(s) 16, drawn to at least one computer entity.

Group IV, claim(s) 17-20, drawn to a method of operating a print service provider facility.

Group V, claim(s) 21-30, drawn to a method of operating a print merchant operation for matching a plurality of orders.

Group VI, claim(s) 31, drawn to at least one computer entity.

Art Unit: 3625

The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Regarding the other recited methods of operation (i.e. Groups IV and V)

The application recites multiple methods (processes) of operation (use) of various operations. The method of operating an on-line retailing operation for retailing of at least one print product to a customer will be considered as the main invention in the claims. See PCT Article 17(3)(a) and §1.476(c).

Group IV recites a method of operating a print service provider facility; and

Group V recites a method of operating a print merchant operation.

Each of Group IV claims 17-20, and Group V claims 21-30 lack the same or corresponding technical features of Group I claims 1-12. Such technical features would be those steps recited in Group I which serve to operate an on-line retailing

Art Unit: 3625

operation. For example, neither of Group IV or Group V claims recite the technical feature of displaying a plurality of image items for remote viewing by a customer. Further, neither of the Group IV or Group V claims recite the technical feature of transacting order with a customer, or of transacting with a print merchant. Neither of Group IV or Group V claims recite a technical feature which engages a customer at all; and only Group V claims even recite a "print merchant"--though Group V claims do not recite a technical feature which is directed to transacting an order with itself.

Accordingly, unity of invention is lacking for Groups I, IV, and V because such Groups are not so linked as to form a single general inventive concept.

Regarding the different recited categories of invention (i.e. Groups II, III, and VI)

Categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or

Art Unit: 3625

- (2) A product and process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

See 37 CFR §1.475.

In the instant case, only item subsection "(4)" applies. However, the apparatus or means provided in Group II, III, and VI fail to recite the manner in which they are specifically designed for carrying out the method of Group I (or of Groups IV or V, for that matter).

Group II claims 13-15 recite an on-line image content retailer operation having at least one computer entity. There is no recitation in Group II that the on-line image content retailer comprises an apparatus or means which is specifically designed for carrying out the steps recited in Group I for the purposes of operating an on-line retailing operation. Further, there is no recitation in Group II that even the at least one computer entity is specifically designed for such purpose recited in Group I--Group II claims 13-15 merely recite at least

Art Unit: 3625

one computer entity capable of performing the specific steps for purposes of assisting the Group II category of invention to function in its capacity as an on-line image content retailer operation.

Group III claim 16, and Group VI claim 31 recite, respectively, at least one computer entity and capable of, and at least one computer entity configured for performing certain functions. There is no recitation that either of these at least one entities are specifically designed for carrying out the method of Group I (or of Groups IV or V, for that matter). Group III is merely recited as being capable of performing steps for the purpose recited in Group I--Group III, however, is not recited as being specifically designed for such purpose. Group VI is recited as being configured to perform certain steps, however, such steps are not for the purposes of operating an on-line retailing operation.

Accordingly, unity of invention is lacking for Groups I (or IV or V, for that matter), II, III, and VI because such Groups are not drawn only to one of the combinations of categories identified in 37 CFR §1.475.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be

Application/Control Number: 10/088,715

Page 7

Art Unit: 3625


examined even though the requirement be traversed (37 CFR
1.143).

Art Unit: 3625

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Smith whose telephone number is (571) 272-6763. The examiner can normally be reached on M-F 6:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (571) 272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jeffrey A. Smith
Primary Examiner
Art Unit 3625

jas